UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/589,084	06/08/2000	Yoshikazu Kobayashi	071671/0153	9809

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EXAMINER
LAFORGIA, CHRISTIAN A

ART UNIT	PAPER NUMBER
2131	

DATE MAILED: 08/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/589,084	KOBAYASHI, YOSHIKAZU
	Examiner	Art Unit	
	Christian La Forgia	2131	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>03 June 2005</u>.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213. .

Disposition of Claims

4)☒ Claim(s) *1-18* is/are pending in the application.

  4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

  Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

  Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

  a)☐ All b)☐ Some * c)☐ None of:

  1.☐ Certified copies of the priority documents have been received.

  2.☐ Certified copies of the priority documents have been received in Application No. _____.

  3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

  * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
  Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
  Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

1.   The amendment filed 03 June 2005 has been noted and made of record.

2.   Claims 1-18 have been presented for examination.

Response to Arguments

3.   In response to applicant's arguments against the references individually, one cannot show

nonobviousness by attacking references individually where the rejections are based on

combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re*

Merck & Co., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

4.   See further rejections that follow.

Claim Rejections

5.   The text of those sections of Title 35, U.S. Code not included in this action can be found

in a prior Office action.

6.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed
> in the United States before the invention by the applicant for patent or (2) a patent granted on an application for
> patent by another filed in the United States before the invention by the applicant for patent, except that an
> international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this
> subsection of an application filed in the United States only if the international application designated the United
> States and was published under Article 21(2) of such treaty in the English language.

7.   Claims 1-4, 6-12, and 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable

over U.S. Patent No. 6,222,859 to Yoshikawa, hereinafter Yoshikawa, in view of U.S. Patent No.

6,430,178 to Yahiro, hereinafter Yahiro.

8.   As per claims 1-3, Yoshikawa teaches a telephone communication system comprising:

a public network (Figure 3 [block 4]; column 2, lines 57-65; column 5, lines 55-59),

a specific ISP network (Figures 2, 3; column 2, lines 18-23; column 5, lines 47-51), and

a plurality of telephone sets accommodated in the public network (Figures 1, 2 [blocks

T151-T153], 3 [blocks 1, 2], 4; column 2, lines 22-28; column 5, lines 47-51; column 6, lines 5-

10),

wherein when a calling telephone set, which is a subscriber to the specific ISP network

provides connection point data specific to said specific ISP network for making internet service

telephone communication to a called telephone set, said connection point data provided using the

public network, the called telephone set receiving the connection point data from the public

network and connecting itself to the specific ISP network according to the connection point data,

and the calling telephone set connecting itself to the specific ISP network (column 7, lines 25-42;

column 11, lines 28-40),

the connection point data including at least an IP address in the specific ISP network and

the telephone number of a point to be connected to the specific ISP network (column 5, lines 60-

67; column 7, lines 25-42; column 11, lines 28-40).

9.   Yoshikawa does not teach a push-button telephone set having various function keys being

provided between each of the plurality of telephone sets and the public network with a function

of sending out a call from each telephone set. It would have been obvious to one having

ordinary skill in the art at the time the invention was made to use a push-button telephone since

the Examiner takes Official Notice of the equivalence of computer terminals for their use in the

phone calling art and the selection of any of these known equivalents to a computer terminal with

phone calling capabilities would be within the level of ordinary skill in the art.

10.   Yoshikawa does not disclose wherein said called and calling parties are connected for making said internet service telephone communication using the same specific ISP network.

11.   It would have been obvious to one of ordinary skill in the art at the time the invention was made for the called and calling parties to be connected using the same specific ISP network, since Yahiro states at column 1, lines 27-45 that such a modification would allow for a smoother transmission of data.

12.   Regarding claims 4, 11, and 12, Yoshikawa teaches wherein functions of each telephone set are executed on a personal computer (Figure 4; column 6, lines 5-65).

13.   Regarding claims 6, 15 and 16, Yoshikawa teaches:

a ten-key unit having dial keys and a function key for indicating an internet telephone service (Figure 4 [block 14]; column 6, lines 20-42);

a display unit for displaying a call arrival notification and results of various processes in the telephone set (Figure 4 [block 15]; column 6, lines 32-42);

an accumulating unit for storing telephone number data and access identifier data of internet connection points to be connected by the calling and called sides (column 8, lines 31-48; column 9, lines 51-67; column 11, lines 27-40; column 13, lines 15-38);

a voice codec to be started by a command for voice communication in the specific ISP network (Figure 4 [block 18]; column 6, lines 52-55);

a telephone set control unit for detecting depressed push-buttons in the ten-key unit, obtaining the connection point data from the accumulating unit, sending out dial data and

connection point data via the public network, starting the voice codec when the dialed side has

been connected to the specific ISP network and, upon arrival of a call, retrieving the connection

point data of the calling side, effecting connection to the specific ISP network by retrieving and

referring to the accumulating unit according to the connection point data and informing the

calling side of the connection (Figures 1, 2 [blocks T151-T153], 3 [blocks 1, 2], 4; column 2,

lines 22-28; column 5, lines 47-51; column 6, lines 5-10).

14.   Regarding claims 7, 17, and 18, Yoshikawa teaches wherein each telephone set further

comprises an encryption unit for permitting exchange of connection point data in terms of

ciphers (column 8, lines 31-48).

15.   As per claims 8-10, Yoshikawa teaches an Internet communication method comprising

steps of:

        providing, by a calling telephone set that is a subscriber to a specific ISP network , of

connection point data for making internet service telephone communication to a called telephone

set, said connection point data being specific to said specific ISP and being transmitted using a

public network (column 7, lines 25-58; column 11, lines 28-50),

        the called telephone set receiving the connection point data from the public network and

connecting to the specific ISP network on the basis of the connection point data (column 5, lines

60-67; column 7, lines 25-42; column 11, lines 28-40), and

        the calling telephone set connecting to the specific ISP network (column 7, lines 51-58),

the connection point data including at least an IP address in the specific ISP network and a telephone number of a point to be connected to the specific ISP network (column 5, lines 60-67; column 7, lines 25-42; column 11, lines 28-40).

16.   Yoshikawa does not teach a push-button telephone set having various function keys being provided between each of the plurality of telephone sets and the public network with a function of sending out a call from each telephone set. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a push-button telephone since the Examiner takes Official Notice of the equivalence of computer terminals for their use in the phone calling art and the selection of any of these known equivalents to a computer terminal with phone calling capabilities would be within the level of ordinary skill in the art.

17.   Yoshikawa does not disclose wherein said called and calling parties are connected for making said internet service telephone communication using the same specific ISP network.

18.   It would have been obvious to one of ordinary skill in the art at the time the invention was made for the called and calling parties to be connected using the same specific ISP network, since Yahiro states at column 1, lines 27-45 that such a modification would allow for a smoother transmission of data.

19.   Claims 5, 13, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshikawa and Yahiro as applied to claim 1 above, and further in view of U.S. Patent No. 6,690,654 to Elliott et al., hereinafter Elliott.

20.   Regarding claims 5, 13, and 14, Yoshikawa and Yahiro do not teach wherein functions of

each telephone set are executed with an IVR (interactive voice response) unit or a facsimile data

server or a voice recognition dialer or a voice mail.

21.   It would have been obvious to one of ordinary skill in the art at the time the invention

was made to have the telephone functions executed with an IVR or a facsimile data server or a

voice recognition dialer or a voice mail (Elliott: column 4, lines 48-65), since Elliott states at

column 1, lines 41-48 that such a modification would allow communicating parties to exchange

information in a conference setting.

22.   Claims 1-4, 6, 8-12, 15, and 16 are rejected under 35 U.S.C. 102(e) as being anticipated

by U.S. Patent No. 6,847,632 to Lee et al., hereinafter Lee.

23.   As per claims 1-3, Lee teaches a telephone communication system comprising:

        a public network (Figure 2 [blocks 62, 64, 66]),

        a specific ISP network (Figure 2 [blocks 58-60], column 6, lines 32-53, column 7, line 36

to column 8, line 11), and

        a plurality of telephone sets accommodated in the public network (Figure 2 [blocks 50,

51, 52, 55], column 6, line 22 to column 8, line 11),

        wherein when a calling telephone set, which is a subscriber to the specific ISP network

provides connection point data specific to said specific ISP network for making internet service

telephone communication to a called telephone set, said connection point data provided using the

public network, the called telephone set receiving the connection point data from the public

network and connecting itself to the specific ISP network according to the connection point data,

and the calling telephone set connecting itself to the specific ISP network (Figure 3, column 8,

line 13 to column 10, line 3),

the connection point data including at least an IP address in the specific ISP network and

the telephone number of a point to be connected to the specific ISP network (Figure 3 [blocks

305, 309], column 9, line 57 to column 10, line 3),

a push-button telephone set having various function keys being provided between each of

the plurality of telephone sets and the public network with a function of sending out a call from

each telephone set (column 6, line 22 to column 8, line 11),

wherein said called and calling parties are connected for making said internet service

telephone communication using the same specific ISP network (Figure 3 [block 310], column 3,

lines 21-35, column 9, line 57 to column 10, line 3). Lee discloses effectuating a telephone

conversation using voice over the Internet, also known as voice over Internet protocol and VoIP.

U.S. Patent No. 6,445,697 to Fenton states at column 1, lines 52-54 that it is a requirement of

VoIP that both ends of the conversation be connected to the same packet-switched network.

Therefore, the disclosure of VoIP teaches that both parties are connected to the same network in

order for the call to take place.

24.   Regarding claims 4, 11, and 12, Lee teaches wherein functions of each telephone set are

executed on a personal computer (Figure 2 [block 53], column 7, lines 36-56).

25.   Regarding claims 6, 15 and 16, Lee teaches:

a ten-key unit having dial keys and a function key for indicating an internet telephone

service (Figure 5 [block 524], column 10, line 4 to column 15, line 66);

a display unit for displaying a call arrival notification and results of various processes in

the telephone set (Figure 5 [block 525], column 10, line 4 to column 15, line 66);

an accumulating unit for storing telephone number data and access identifier data of

internet connection points to be connected by the calling and called sides (Figure 5 [blocks 506,

507, 517, 518, 522, 523], column 10, line 4 to column 15, line 66);

a voice codec to be started by a command for voice communication in the specific ISP

network (Figure 5 [blocks 508, 519], column 10, line 4 to column 15, line 66);

a telephone set control unit for detecting depressed push-buttons in the ten-key unit,

obtaining the connection point data from the accumulating unit, sending out dial data and

connection point data via the public network, starting the voice codec when the dialed side has

been connected to the specific ISP network and, upon arrival of a call, retrieving the connection

point data of the calling side, effecting connection to the specific ISP network by retrieving and

referring to the accumulating unit according to the connection point data and informing the

calling side of the connection (column 10, line 4 to column 15, line 66).

26.   As per claims 8-10, Lee teaches an Internet communication method comprising steps of:

providing, by a calling telephone set that is a subscriber to a specific ISP network , of

connection point data for making internet service telephone communication to a called telephone

set, said connection point data being specific to said specific ISP and being transmitted using a

public network (figure 3 [block 305], column 8, line 13 to column 10, line 3),

the called telephone set receiving the connection point data from the public network and

connecting to the specific ISP network on the basis of the connection point data (Figure [blocks

309, 310], column 8, line 13 to column 10, line 3), and

the calling telephone set connecting to the specific ISP network (Figure 3 [block 303],

column 8, line 13 to column 10, line 3),

the connection point data including at least an IP address in the specific ISP network and

a telephone number of a point to be connected to the specific ISP network (figure 3 [blocks 308,

309], column 8, line 13 to column 10, line 3);

a push-button telephone set having various function keys being provided between each of

the plurality of telephone sets and the public network with a function of sending out a call from

each telephone set (column 6, line 22 to column 8, line 11),

wherein said called and calling parties are connected for making said internet service

telephone communication using the same specific ISP network (Figure 3 [block 310], column 3,

lines 21-35, column 9, line 57 to column 10, line 3). Lee discloses effectuating a telephone

conversation using voice over the Internet, also known as voice over Internet protocol and VoIP.

U.S. Patent No. 6,445,697 to Fenton states at column 1, lines 52-54 that it is a requirement of

VoIP that both ends of the conversation be connected to the same packet-switched network.

Therefore, the disclosure of VoIP teaches that both parties are connected to the same network in

order for the call to take place.

27.   Claims 5, 13, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee

in view of U.S. Patent No. 6,195,357 to Polcyn, hereinafter Polcyn.

28.   Regarding claims 5, 13, and 14, Lee does not disclose wherein functions of each telephone set are executed with an IVR (interactive voice response) unit or a facsimile data server or a voice recognition dialer or a voice mail.

29.   Polcyn teaches wherein functions of each telephone set are executed with an IVR (interactive voice response) unit or a facsimile data server or a voice recognition dialer or a voice mail (figure 1 [block 100], column 3, line 66 to column 4, line 18).

30.   It would have been obvious to one of ordinary skill in the art at the time the invention was made to execute using an IVR unit, since Polcyn states at column 4, lines 3-18 that such a modification would provide switching and conferencing functionality to enable interconnection of any received communications, as well as provide automated speech functionality so that recorded messages may be selectively introduced into voice communications.

31.   Claims 7, 17, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee in view of Yoshikawa.

32.   Regarding claims 7, 17, and 18, Lee does not teach wherein each telephone set further comprises an encryption unit for permitting exchange of connection point data in terms of ciphers.

33.   Yoshikawa teaches wherein each telephone set further comprises an encryption unit for permitting exchange of connection point data in terms of ciphers (column 4, lines 1-6).
It would have been obvious to one of ordinary skill in the art at the time the invention was made to include an encryption unit, since Yoshikawa states at column 4, lines 1-6 that such a modification would ensure secure highly private communications over the Internet.

Conclusion

34.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure.

35.   The following patents are cited to further show the state of the art with respect to

connecting calls over a packet switched network, such as:

United States Patent No. 6,636,508 to Li et al., which is cited to show a resource

conservation system that conserves network bandwidth and improves voice quality by

connecting parties on a common network.

United States Patent No. 6,097,804 to Gilbert et al., which is cited to show completing a

voice connection between first and second voice terminals in a switched telephone network.

United States Patent No. 6,594,269 to Polcyn, which is cited to show a server that

integrates voice communications and provides point-to-point, conference or broadcast

connections of multiple users.

36.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Christian La Forgia whose telephone number is (571) 272-3792.

The examiner can normally be reached on Monday thru Thursday 7-5.

37.   If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

38.   Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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